

Amendment
Serial No. 09/806,091

Docket No. PHF99621
August 2004

REMARKS

Claims 1-4 are pending in the application. Claims 1, 3 and 4 stand rejected. Claim 2 is objected to but would be allowable if rewritten in independent form.

Claims 2 and 3 have been amended. Claims 5-7 have been added. No new matter has been added.

Claims 1, 3 and 4 stand rejected pursuant to 35 USC §103(a) as being unpatentable over USP No. 5,491,516 to Casvant. It is the examiner's position that, with regard to claim 1, "Casavant teaches the claimed 'method for encoding video signals ... Although Casavant fails to explicitly teach 'delay being decreased by a quantity equal to 'one field' and also delay being increased by a quantity equal to 'one field' duration, however, it would have been obvious ... that removal/elimination of redundant field would decrease the delay and repeating the fields would increase the delay equal to the amount removed/added."

Applicant respectfully disagrees with, and explicitly traverses the examiner's reasons for rejecting the claims. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest **all** the claim limitations.

With regard to claim 1, this claim recites

1. A method for encoding video signals corresponding to a sequence of frames each of which originally consists of two fields F1 and F2, in which the encoding step is preceded by a preprocessing step which itself comprises the sub-steps of:

- (A) receiving the successive frames and delaying each of them with a delay of at least two fields ;
- (B) adjusting said delay according to the following dominance change criterion:
 - (a) when a change from an F1 dominance to an F2 dominance is detected, the first field of the first F2 dominant frame is suppressed, said delay being therefore decreased by a quantity equal to "one field" duration;

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(b) when a change from an F2 dominance to an F1 dominance is detected, the last field of the last F2 dominant frame is repeated, the delay being therefore increased by a quantity equal to "one field" duration.

Casavant teaches a field elimination apparatus for video compression/decompression. The system includes a memory for storing two fields of image data and providing fields of image data separated by one frame interval. Image data from corresponding fields of successive frames are subtracted to generate field differences. The differences are accumulated and if the accumulated difference is less than a predetermined value the most recent field is excised. Hence, Casavant teaches removing or excising fields from the data stream and does not disclose "receiving the successive frames and delaying each of them with a delay of at least two fields," as is recited.

As the examiner rightly states Casavant does not disclose elements of the present invention ("Casavant fails to explicitly teach 'delay being decreased by a quantity equal to 'one field' and also delay being increased by a quantity equal to 'one field' duration"), applicant believes that the examiner has engaged in an impermissible use of the teachings of the present invention as a blueprint to find elements claimed in the Casavant reference. In this case, the examiner provides no additional references and proceeds to impose motivation or reasons for amending the cited reference to include the missing claim elements. Hence, rather than finding a motivation or suggestion to develop the novel features of the present invention in the Casavant reference itself, the examiner has implied such motivation or suggestion after reading the description of the present invention. Applicant believes that the examiner has engaged in an impermissible use of the teachings of the present invention to find the present invention obvious in view of the Casavant reference.

In the matter of obviousness there is a great emphasis placed on "the importance of the motivation to combine." For example, the court in Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal, Inc. 231 F. 3d. 1339, 56 USPQ2d. 1641, 1644 (Fed. Cir. 2000) found that:

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an examiner ... may often find every element of a claimed invention in the prior art. If identification of each claimed element of the prior art was sufficient to negate patentability, very few patents would ever issue. Furthermore rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner ... to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention ... To counter this potential weakness in the obviousness construct, the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. *id.* quoting *In re Rouffet*, 149 F.3d 1350, 1357-58, 47 USPQ 2d 1453, 1457 (Fed. Cir. 1998)

In this case, the examiner has not shown any reason, either explicitly or implicitly, in the Casavant reference that would render the invention obvious. Rather the examiner merely states that "it would have been obvious ... that removal/elimination of redundant field would decrease the delay and repeating the fields would increase the delay equal to the amount removed/added." Accordingly, applicant believes that the examiner has incorporated the teachings of the present invention in the cited reference to reject the claims and that this is impermissible.

Accordingly, applicant submits that the rejection cannot stand. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

With regard to claims 2, 3 and 4, these claims ultimately depend from independent claim 1, which has been shown to be not obvious and allowable in view of the cited references. Accordingly, claims 2, 3 and 4 are also allowable by virtue of their dependence from an allowable base claim.

With regard to claim 2, the examiner has objected to this claim but indicated that this claim would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

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Applicant, through his attorney, wishes to thank the examiner for his indication of allowable subject matter in claim 2. However, in view of the remarks made herein, applicant believes that the claims are in a condition for allowance and elects, at this time, not to amend claim 2 as indicated by the examiner. Applicant reserves the right to amend the claims at a subsequent time.

Having addressed the examiner's rejections under 35 USC § 103, applicant submits that for the amendments and remarks made herein the reasons for the examiner's objections and rejections have been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the objections and rejections and that a Notice of Allowance be issued.

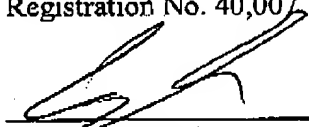
Should any unresolved issues remain that the examiner believes may be resolved via a telephone call, the examiner is invited to call Applicant's attorney at the telephone number below. No fees are believed necessary for the filing of this Amendment and Response.

Date:

8/11/04

Respectfully submitted,

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